



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,129	12/03/2001	Alfred Eisenberg	CSM-0002	2157
7590	12/27/2007		EXAMINER	
WILFRED LAM INNOVATION MANAGEMENT SCIENCES P.O. BOX 1169 LOS ALTOS, CA 94043-1169			DIVECHA, KAMAL B	
			ART UNIT	PAPER NUMBER
			2151	
			MAIL DATE	DELIVERY MODE
			12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/007,129	EISENBERG, ALFRED	
	Examiner	Art Unit	
	KAMAL B. DIVECHA	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 September 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-54 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-54 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in response to communications filed on 9/17/07.

Claims 1-54 are pending in this application.

Reopening the Prosecution After Appeal Brief

In view of the Appeal Brief filed on September 17, 2007, PROSECUTION IS HEREBY REOPENED. The Office Action sets forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Response to Arguments

Applicant's arguments filed in the brief have been fully considered but they are not persuasive.

In the Appeal Brief, Applicant argues in substance that:

- a. In one embodiment, the present invention is a system which permits the allocation of video resources based upon the interpretation of an instant message from one of the two nodes. That is, the instant message server and the video conference resource allocator are designed to work together to enable the initiation of a video conference by the instant messaging server in response to a request thereof. This is not a function provided by the mere combination of known parts (Brief, pg. 12-13, pg. 17-18, pg. 20).

In response to argument [a], Examiner respectfully disagrees.

Independent claim 1 recites:

A system, which may be used with at least two client nodes which are adapted to communicate with one another via an instant messaging utility and further which are adapted to communicate with one another via a video conference utility, comprising:

an instant messaging server for supporting instant messages between the at least two client nodes;
a second server for supporting a video conference between the at least two client nodes; and
a video conference resource allocator, communicatively coupled to said instant messaging server and said second server, said video conference resource allocator adapted to allocate video conference resource in said second server in response to a request for a video conference from said instant messaging server, such that a video conference may be initiated between the at least two client nodes, and further adapted to communicate to the at least two client nodes, via said instant message server, resource information enabling the at least two client nodes to join the video conference.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., feature as in argument a) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2151

b. While Gudjonsson...it does not disclose or suggest an IM server configured to initiate a video conference in response to an instant message communication sent by a user. The reference does not teach or suggest the allocation of video conference resources in response to a request for a video conference from an instant messaging server (Brief, pg. 13, pg. 17).

In response to argument [b], Examiner respectfully disagrees.

Again, applicant attempts to argue features that are not recited in the claims. Once again, applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the specification fails to support the limitation "allocation of video resources in response to a request for a video conference" (See 35 U.S.C. 112, first paragraph rejection set forth herein).

Moreover, Applicant in the brief, pg. 16, has clearly admitted that initiation of video conferences in Bruno are handled in a fairly traditional manner, via a resource allocator referred to as MRCS.

In other words, Applicant admits that Bruno discloses allocation of video conference resources in response to a video conference request (Brief, pg. 16).

On the other hand, Gudjonsson discloses an IM server configured to initiate a video conference, audio conference, and or text conference (See fig. 9: iPulse Utility, col. 25 L5-42).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Gudjonsson in view of Bruno (See the detailed claim rejection).

c. Arguments pertaining to Tang reference (Brief, pgs. 14-16).

The arguments are moot in view of new grounds of rejection (See the detailed rejection).

d. More specifically, the reference does not teach or suggest that "at least two client nodes communicate via IM server, resource information enabling the at least two client nodes to join a video conference" (Brief, pg. 18, 19).

In response to argument [d], Examiner respectfully disagrees.

Gudjonsson teaches and discloses the process of initiating a text, audio, web and/or video conference through iPulse Utility via the server, more specifically, via the ipulse utility server or IM server, wherein the at least two clients communicate resource information enabling the two clients to join a conference (See fig. 9, col. 23 L32 to col. 24 L67, col. 25 L5-42, col. 33 L49 to col. 34 L8, col. 37 L35 to col. 38 L8).

Therefore, Gudjonsson and Bruno do teach and suggest the subject matter as in claims 1-54.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Independent claim 1 recites:

A system, which may be used with at least two client nodes which are adapted to communicate with one another via an instant messaging utility and further which are adapted to communicate with one another via a video conference utility, comprising:

an instant messaging server for supporting instant messages between the at least two client nodes; a second server for supporting a video conference between the at least two client nodes; and

a video conference resource allocator, communicatively coupled to said instant messaging server and said second server, said video conference resource allocator adapted to allocate video conference resource in said second server in response to a request for a video conference from said instant messaging server, such that a video conference may be initiated between the at least two client nodes, and further adapted to communicate to the at least two client nodes, via said instant message server, resource information enabling the at least two client nodes to join the video conference.

Initially, the originally filed specification clearly fails to disclose, teach and/or suggest the resource allocator adapted to allocate video conference resources in said second server in response to a request for a video conference from said instant messaging server, such that a video conference may be initiated between the at least two client nodes (See specification, pg. 6 lines 11-17, pg. 10 lines 23 to pg. 11 line 7).

Note: The feature(s) was first introduced in the claims in the amendments filed 7/22/05 in response to the non-final office action on 1/21/05.

At best, the original specification discloses a resource allocator which is configured to create a video conference (pg. 10 lines 23 to pg. 11 line 7).

The cited portion of the specification in the brief (Brief, pg. 9) for supporting the feature fails to provide any indication or suggestion of the fact "allocating video conference resources in the second server..."

As such, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2-54 are rejected for the same reasons as set forth in claim 1.

Applicant is advised to take appropriate action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the term "may be" in the preamble and body of the claim. The term renders the claim indefinite because it is unclear whether the limitation followed by the term is actually implemented or not, thus, enabling the scope of the claim unascertainable.

Claims 2-54 are rejected for the same reasons as set forth in claim 1.

Applicant is advised to take appropriate action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 1 recites:

A system, which may be used with at least two client nodes which are adapted to communicate with one another via an instant messaging utility and further which are adapted to communicate with one another via a video conference utility, comprising:

an instant messaging server for supporting instant messages between the at least two client nodes; a second server for supporting a video conference between the at least two client nodes; and

a video conference resource allocator, communicatively coupled to said instant messaging server and said second server, said video conference resource allocator adapted to allocate video conference resource in said second server in response to a request for a video conference from said instant messaging server, such that a video conference may be initiated between the at least two client nodes, and further adapted to communicate to the at least two client nodes, via said instant message server, resource information enabling the at least two client nodes to join the video conference.

Initially, the claim fails to fall into any of the four enumerated category of the patentable subject matter as set forth above.

Although the claim recites the term "system", the claim actually lacks the necessary physical articles/objects/elements/components to constitute a system, a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter.

As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

[Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and

Art Unit: 2151

functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make the claim statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer”].

In the instant case, apart from applying broadest reasonable interpretation, the specification clearly discloses the Instant Messaging server as a piece of software (specification, pg. 14 L5-10), and based on the broadest reasonable interpretation, the second server and video conference allocator can simply be interpreted and/or implemented as software components, thus directing the claim to be interpreted as a computer program and/or software, i.e. software per se.

As such, the claim is not limited to the system comprising physical elements and/or components.

Hence, the embodiment of the claim fails to place the claimed invention; more specifically claims 1-27, squarely within one statutory class of invention as set forth above.

Claims 2-27 are rejected for the same reasons as set forth in claim 1.

Independent claim 28 recites:

A communication method which may be employed in a system including at least two client nodes which are adapted to communicate with one another via an instant messaging utility and further which are adapted to communicate with one another via a video conference utility, comprising:

providing a instant messaging server for supporting instant messages between the at least two client nodes;

providing a second server for supporting a video conference between the at least two client nodes; and

providing a video conference resource allocator, communicatively coupled to said instant messaging server and said second server, said video conference resource allocator adapted to allocate video conference resource in said second server in response to a request for a video conference from said instant messaging server, such that a video conference may be initiated between the at least two client nodes, and further adapted to communicate to the at least two client nodes, via said instant message server, resource information enabling the at least two client nodes to join the video conference.

Initially, the claim fails to fall into any of the four enumerated category of the patentable subject matter as set forth above. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter, nor a machine or system.

The term “communication method” can be interpreted as a protocol. In other words, a communication method can be employed as a protocol, which fails to fall into any of the enumerated class of statutory subject matter.

As set forth above, the IM server, the second server and the resource allocator can all be interpreted as software components, resulting in a claim, as a whole, to be directed towards software, i.e. software per se.

Furthermore, the communication method is achieved by providing the software components. In other words, the software components are provided as a communication method.

As such, the embodiment of the claim 26 fails to place the claimed invention; more specifically claims 28-54, squarely within one statutory class of invention as set forth above.

Claims 29-54 are rejected for the same reasons as set forth in claim 28.

Applicant is advised to take appropriate action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudjonsson et al. (hereinafter Gudjonsson, US 6,564,261) in view of Bruno et al. (hereinafter Bruno, US 6,020,915).

As per claim 1, Gudjonsson teaches a system, which may be used with at least two client nodes which are adapted to communicate with one another via an instant messaging utility (fig. 8-9: using iPulse utility), and further which are adapted to communicate with one another via a audio/video conference utility (fig. 9: iPulse utility with voice, text and teleconferencing, col.7, lines 42-51), comprising:

an instant messaging server for supporting instant messages between the at least two client nodes (fig. 8-9: the usage of iPulse IM utility implies the usage of IM server, fig 2 item #3);

a second server for supporting a video conference between video conference participants using the at least two client nodes (fig. 2 item # 3, col.7, lines 42-51: using SIP protocol, col. 33 L49 to col. 34 L8: MCU);

initiating a video conference between the at least two client nodes in response to request for such a conference from said instant messaging server such that a video conference may be initiated between the two clients (col. 24 L 33 to col. 25 L20), and communicating to the at least

two client nodes resource information enabling the at least two client nodes to join the video conference (fig. 5, fig. 9: iPulse application with text, voice and web conferencing capability, col.7, lines 42-51, col. 3 L14-28, col. 8 L66 to col. 9 L40, col. 11 L31-65, col. 12 L55 to col. 13 L50, col. 23 L31 to col. 24 L67: using SIP protocol to initiate the conference, col. 33 L49 to col. 34 L7: using MCU, col. 37 L35 to col. 38 L7).

However, Gudjonsson does not explicitly teach a resource allocator communicatively coupled to instant messaging server and second server to allocate resources for a videoconference in response to a request for a video conference.

Bruno teaches a resource allocator communicatively coupled to a videoconference server to allocate resources for a videoconference (col.4, line 62-col.5, line 10).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Gudjonsson in view of Bruno in order to use resource allocation for a video conference in order to provide enough resources to establish a video conference (Bruno, col.2, lines 58-67).

One ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Gudjonsson, Tang, and Bruno, in order to provide a system to have enough resource to establish a video conference between two users (Bruno, col.2, lines 58-67).

As per claim 2, Gudjonsson discloses the system wherein at least one of the videoconference participants participates in the videoconference via the public switched telephone network (PSTN) (Gudjonsson: col.7 L35 to col. 8 L34 and fig. 9, col. 25 L1-20).

As per claims 3, Gudjonsson discloses the system wherein at least one of the videoconference participants participates in the videoconference via cellular communication (Gudjonsson, col.3, line 53-54, col. 7 L35 to col. 8 L34, col. 25 L1-20).

As per claim 4, Gudjonsson discloses the system wherein at least one of the videoconference participants participates in the videoconference via a computer (Gudjonsson: fig. 1-4, col.3, line 57, col. 7 L35 to col. 8 L34, col. 25 L1-20).

As per claim 5, Gudjonsson discloses the system wherein at least one of the videoconference participants participates in the videoconference via a network gateway (Gudjonsson: fig. 2 item #1, col. 25 L1-20).

As per claim 6, Gudjonsson discloses the system wherein at least one of the videoconference participants participates in the videoconference via a video conferencing standard protocol (Gudjonsson, col.7, line 60).

As per claim 7, Gudjonsson does not disclose the system wherein at least one of the client nodes participates in the video conference via an ISDN protocol.

Bruno explicitly discloses the system wherein the least one of the client nodes participates in the video conference via an ISDN protocol (col. 3 L40-64).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Gudjonsson in view of Bruno in order to enable video conferencing over the ISDN protocol.

One of ordinary skilled in the art would have been motivated because it would have enabled video conferencing over the ISDN network (Bruno: col. 3 L46-64).

As per claim 8, Gudjonsson does not disclose the system wherein at least one of the client nodes participates in the video conference via ATM standard protocol.

Bruno explicitly discloses the system wherein the least one of the client nodes participates in the video conference via ATM standard protocol (col. 3 L45 to col. 4 L46).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Gudjonsson in view of Bruno in order to enable video conferencing over the ATM network.

One of ordinary skilled in the art would have been motivated because it would have enabled video conferencing over the ATM network (Bruno: col. 3 L45 to col. 4 L46).

As per claim 9, Gudjonsson discloses the system wherein the instant messaging server contains information related to communication modes of the client nodes used to participate in the video conference (Gudjonsson, col.7, lines 35-67, col. 28 L9-64, col. 35 L4-67).

As per claim 17, Gudjonsson discloses the system further comprising a database communicatively coupled to said instant messaging server for storing information related to the client nodes used to initiate the video conference (Gudjonsson, col.7, lines 35-67, col. 28 L9-64, col. 35 L4-67).

As per claim 18, Gudjonsson discloses the system wherein the instant messaging server receives the information from the database (Gudjonsson, col.7, lines 35-67, col. 28 L9-64, col. 35 L4-67).

As per claim 27, Gudjonsson discloses the system wherein the second server is a network video conferencing server, which supports videoconferences using a network video conferencing

Art Unit: 2151

protocol (Gudjonsson, col.7, line 60; col. 33 L49 to col. 34 L8, fig. 2 item #3, and fig. 9: iPulse application).

As per claims 10-16, 19-26, 28-54, they do not teach or further define over the limitations in claims 1-9, 17, 18 and 27. Therefore claims 10-16, 19-26, 28-54 are rejected for the same reasons as set forth in claims 1-9, 17, 18 and 27.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Liversidge et al., Pub. No.: US 2002/0076025 A1: Method and System for Automatic Handling of Invitations to join communications session in a virtual team environment.
- Stimmel, US 6,678,719: Virtual Workplace intercommunication tool.
- Tang et al., US 5,793,365: Providing User Interface enabling access to distributed workgroup members.

Conclusion

This Action is made Non-Final.

Examiner's Remarks: The teachings of the prior art should not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner, in order to move prosecution forward.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal Divecha/

Kamal Divecha
Art Unit 2151
December 10, 2007.



JEFFREY PWU
SUPERVISORY PATENT EXAMINER